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| 36734 7590 12/10/2009 BAKER & HOSTETLER LLP WASHINGTON SQUARE, SUITE 1100 1050 CONNECTICUT AVE. N.W. WASHINGTON, DC 20036-5304 | | | | |
| EXAMINER | | | | |
| RUHL, DENNIS WILLIAM | | | | |
| ART UNIT | | PAPER NUMBER | | |
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

patents@bakerlaw.com

Office Action Summary

Application No.

10/028,722

Applicant(s)

JOHNSON ET AL.

Examiner

Dennis Ruhl

Art Unit

3689

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 August 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,5,6,10,11 and 15-29 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,5,6,10,11 and 15-29 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB06)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

Applicant's response of 8/11/09 has been entered. The examiner will address applicant's remarks at the end of this office action.

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1,5,6,10,11,15-29, are rejected under 35 U.S.C. 103(a) as being unpatentable over Li (20020072808) in view of Kirkevold et al. (6263322).

The applicant should take notice that in the system claims, the mechanic is not present in the claim scope. The mechanic is referred to in a functional sense as far as the intended user of the various claimed elements. For the system claims, the person that is intended to be the one that enters the data is not part of the claim scope so reciting that it is a mechanic that is to enter information and that it is the mechanic that is the one that is supposed to operate the diagnostic equipment is not further defining any structure to the system as claimed. A recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. A mechanic is fully capable of operating the claimed elements, so the prior art satisfies

what is claimed as will be explained below. Additionally, the prior art satisfies what is claimed with respect to the operation of the diagnostic equipment as will be explained.

For claims 1,6,11,20,21,23-26,28,29, Li discloses a system and method for providing vehicle information. Li discloses a system where a user (vehicle owner or automotive repair shop service associate, any user) can enter information concerning a given vehicle and the system can then analyze that information to give a diagnosis of what may be wrong with the vehicle (done via a processor as claimed). A service solution is determined as claimed. The system also can determine the warranty status of the vehicle based on the diagnosis of the problem (is problem covered under warranty, yes or no, see figure 11 of Li). See figure 17 and paragraph 61 where it is disclosed that vehicle identification information is entered. The "means for entering the vehicle identification information" is satisfied by the computer interface 80 that allows entry of the claimed type of data. Figure 17 shows the VIN number being entered, which identifies the vehicle. The vehicle problem information entered into the system by the user is the claimed diagnostic information, which is analyzed to arrive at a service solution (using service information as claimed). See paragraph 42 for a disclosure of comparing the received diagnostic information to a symptoms database 90 to determine a diagnosis. The "means for comparing" the received diagnostic information with reference information is module 30, that compares received vehicle diagnostic information to a symptoms database to determine a diagnosis. This module 30 also satisfied the claimed "means for identifying at least one service solution. The results are then displayed as claimed, which also satisfies the claimed "means for displaying",

which is just a display. Databases are used to store the data (for claim 11). Also, see paragraph 45 where it is disclosed that there is a warranty module 41 that identifies warranty solutions, this satisfies the claimed *"means for identifying if the at least one service solution is covered under warranty"*.

Not disclosed by Li is that the diagnostic information is received *"directly from diagnostic equipment"*. In Li the data is entered manually and applicant is claiming a situation that is representative of an automated collection of vehicle diagnostic data. Also not disclosed *for only claim 1* is that the vehicle identification information is entered by a mechanic.

Kirkevold discloses an auto repair shop computer system that manages just about every aspect of a repair shop that one can think of. It is specifically disclosed that the computer system includes *diagnostic* equipment (see figure 1, #1,12,14,16) that analyzes data taken from vehicles *to diagnose a problem*. For example see column 9, line 56 to column 10, line 18. The operator of the diagnostic equipment satisfies the claimed limitation of a mechanic, which is really just a title and is only defining a person. Clearly in the reference it is a repair technician (mechanic) that is operating the diagnostic equipment and repairing the vehicles. Kirkevold is disclosing the fact that is it well known in the auto repair art to take vehicle data directly from vehicle analyzer components 52, that are connected to a vehicle by the repair technician (which is a mechanic and satisfies what is claimed). In Kirkevold, the diagnostic data that is used to diagnose the vehicle problem comes directly from diagnostic equipment that is connected to the vehicles (see figure 1). Also, the examiner notes that Kirkevold

recognizes that Diagnostic Trouble Codes can be retrieved from the on board computer of a vehicle, see column 11, lines 49-51. The on board computer satisfies an onboard monitoring system as is claimed in claim 21. It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Li so that data concerning vehicle problems can be received directly from the diagnostic equipment that is operated by a repair technician (mechanic), as is taught by Kirkevold. This is very well known to one of ordinary skill in the art. The receipt of data directly from diagnostic equipment would be desirable because it allows for more complex troubleshooting to occur, such as the obtaining of data by the various devices disclosed by Kirkevold (engine analyzer, alignment analyzer, brakes analyzer, etc.) that allow for more complex problem analysis than the system of Li can provide with just user objective input. A repair technician (mechanic) would use diagnostic equipment connected to the vehicle, like the disclosed engine analyzer of Kirkevold. The repair technician (mechanic) could also connect to the vehicle's on board computer to obtain error codes (as is disclosed by Kirkevold) and this would then allow problem diagnosis to occur based on the received data. One of ordinary skill in the art would have found it obvious to collect the diagnostic data directly from diagnostic equipment that is operated by a mechanic so that a more accurate diagnosis can occur.

With respect to the claimed entering of the vehicle identification information by a mechanic, Li discloses that a person enters this same information. It may be a customer or it may be an automotive repair shop service associate. The entering of the vehicle information can be done by anyone, it does not matter who is doing it. Because

the rejection results in the vehicle diagnostic information being taken from diagnostic information operated by a mechanic, it would make sense that somebody such as a mechanic at the repair shop would also enter the vehicle identification information. The examiner also notes that it does not appear to matter who it is that enters the data. The method does not depend on a specific individual entering the information and the invention would perform the same if a person other than a mechanic entered the vehicle identification information. The specification does not disclose that having a mechanic enter the vehicle identification information solves any particular problem or that this produces any unexpected result. It also makes sense that if an automotive repair shop service associate is able to enter the information that it would have been obvious to try and have a mechanic also enter the information (maybe the service associate is out sick that day). It would have been obvious to one of ordinary skill in the art at the time the invention was made to have the mechanic enter the vehicle identification information for the above reasons.

For claims 5,10,15, not disclosed is that the entered vehicle identification information is the make, model, and year of the car. In Li, it is disclosed that the VIN (vehicle identification number) is entered. The VIN number represents the make, model, year, and options that the vehicle has. One of ordinary skill in the art would readily appreciate this fact and would have found it obvious to have the vehicle identification information that is entered be the make, model, and year, as claimed. Li discloses the entering of vehicle ID data and modifying Li to accept the make, model,

and year, as opposed to the VIN number, is something that one of ordinary skill in the art would have found obvious.

For claims 22,27, Kirkevold discloses the use of hand held diagnostic equipment, such as equipment 5 and 6 as shown in figure 1. The 103 combination also includes these features as being provided to Li. The 103 combination is providing Li with the ability to collect data from the various devices disclosed by Kirkevold.

For claims 16,17, not disclosed is that Li is configured to receive information (diagnostic and vehicle identification information) wirelessly. Li discloses in paragraph 40 that various communication networks can be used, "or other networking technologies" (i.e. LANs, WANs, global networks). Wireless transmission of information is something that is old and well known in the art. One of ordinary skill in the art would certainly be aware of the fact that there are wireless networks in existence where data can be transferred wirelessly. This is something that one of ordinary skill in the art would be aware of as of the effective filing date for this application. It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide Li with wireless data communication ability, so that the data could be transferred by wireless communication, as is well known in the art.

For claims 18,19, not disclosed is that the data input is configured to use the TCP/IP protocol. The TCP/IP protocol is something that is well known to one of ordinary skill in the art. This type of data transfer protocol was developed many years ago and is something that one of ordinary skill in the art would be very aware of. It would have been obvious to one of ordinary skill in the art at the time the invention was

made to provide the data input of Li with the TCP/IP protocol. In view of the fact that in Li a user can interact with the system from home via computer, one of ordinary skill in the art would recognize that the TCP/IP protocol would be desirable, especially because this kind of protocol is used extensively for the Internet.

3. Applicant's arguments filed 1/4/08 have been fully considered but they are not persuasive.

Applicant's only argument is that the inventors had conceived of the claimed invention prior to the prior art dates for Li and Kirkevold. Applicant has based the patentability of the claims on swearing behind the applied prior art references via a 35 USC 131 declaration. This is not found to be persuasive. The submitted declaration has been considered but is not persuasive. With respect to the alleged date of conception of at least as of "July 6, 1998", there is no evidence in the submitted evidence that this is true. In fact, the submitted document that is the Product Requirement Specification-EVA Approval Comment Form is dated as being sent out to the recipients "March 25, 2009". That date is not prior to the applied prior art and is evidence that the document is not entitled to a date to at least July 6, 1998. Applicant has not addressed this date and it must be assumed that this is the date of the document, otherwise there is no rationale explanation as to why the document alleged to have been from at least "July 6, 1998" is actually dated as of March 25, 2009. That is just under an 11 year difference. As far as the declaration itself and what it addresses, at best it is addressing only claim 11. There are other claims pending that have not

been addressed as far as how the submitted evidence supports what is claimed. The claimed invention in all claims must be addressed because applicant is the one that has to explain to the examiner how each and every limitation is supported by the submitted evidence. This has not been done for all claims and only claim 11 appears to have been addressed. The declaration is only relevant to claim 11 as no other claims have been argued or addressed with respect to the submitted evidence. With respect to part a) of the declaration and with respect to the limitation of searching by vehicle identifying data, this does not seem to be supported by the submitted evidence. Applicant has stated that:

"Further, the host software will include a diagnostics engine which will analyze all incoming data (including OBC [sic, should read OBD] data when available) and generate focused diagnostic results. This diagnostic engine will also (when available) search for and display appropriate Technical Service Bulletins (TSBs) issued by the OEM for the vehicle being worked on."

This does not support the conclusion that applicant has inferred from the above cited language, as follows:

"See the 12th page of Exhibit 1 (labeled as page "7"), section 3.2.1. Thus, the Technical Service Bulletins, On-Board Computer diagnostic routines, and engine diagnostics that utilizes engine analyzer, gas module and scan data input can all

be stored in databases, and need to be searchable by vehicle identifying data to chose the appropriate diagnostic.”

For part c), there is no discussion in the submitted evidence of a database of service related vehicle information including warranty information. The submitted information makes no mention of warranties at all so it cannot be considered to satisfy information relating to warranties as is claimed. Applicant seems to be equating a Technical Service Bulletin to warranty information, which is not persuasive. Technical Service Bulletins do not necessarily contain warranty information as claimed. Because warranty information is not shown in the evidence, the portion of the claim that recites determining warranty status is also not supported by the evidence.

For statement number 4 in the declaration, applicant has stated that they understood that a means for entering configured to enter vehicle identification information into the system by a mechanic would be particularly suitable for a system for use in servicing a vehicle. This is not a submission of any evidence and cannot be accepted. The applicant has to provide evidence, in the form of notes, documents, video, photos, emails, etc. (any evidence that supports what the declarants are declaring) for the 131 to be persuasive. Statements that the inventors understood a claimed limitation as being particularly suitable for use is not any kind of evidence that proves what is alleged.

Overall, due to the date of the evidence being from 2009, and due to the declaration only addressing claim 11, and due to the declaration and the evidence not

supporting all that is claimed, it is found to be non-persuasive and insufficient to remove the prior art references to Li and Kirkevold.

Because applicant only argued the 131 declaration for patentability with respect to only claim 11, and due to the absence of arguments on the merits with respect to claims 1,5,6,10,15-29, the examiner must assume that the rejections of the claims is proper. If applicant felt that the prior art did not teach all limitations that are claimed, then the applicant had the burden of presenting arguments to the examiner (37 CFR 1.111).

4. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dennis Ruhl whose telephone number is 571-272-6808. The examiner can normally be reached on Monday through Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Janice Mooneyham can be reached on 571-272-6805. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Dennis Ruhl/
Primary Examiner, Art Unit 3689